

Amendment and Response

Applicant: Roy Stubbs

Serial No.: 10/625,353

Filed: July 23, 2003

Docket No.: M120.241.101 / 57001US006

Title: ABRASIVE MATERIALS

REMARKS

The following remarks are made in response to the Final Office Action mailed October 19, 2005. In that Office Action, claims 1, 3, 4, and 5 were rejected under 35 U.S.C. §102(e) as being anticipated by German Patent No. 9407622 ("the German Reference"). Claims 2 and 6 were rejected under 35 U.S.C. §103(a) as being unpatentable over the German Reference in view of Hong et al., U.S. Patent No. 4,202,139 ("Hong"). Claims 7-10 were rejected under 35 U.S.C. §103(a) as being unpatentable over the German Reference, in view of Hong as applied to claims 2 and 6 above, and further in view of Cheney et al., U.S. Patent No. 5,309,681 ("Cheney").

With this Response, claims 11-13 have been added and are presented for consideration and allowance. Claims 1-10 remain pending in the application and are presented for reconsideration and allowance.

Support for Amendments

It is respectfully requested that the Examiner enter and consider newly presented claims 11-13. In order to facilitate consideration of those claims, support for the limitations of those claims is provided below.

Support for the limitations of new claim 11 is provided, for example, at p. 5, ll. 24-26.

Support for the limitations of new claim 12 is provided, for example, at p. 5, ll. 24-26.

Support for the limitations of new claim 13 is provided, for example, at p. 3, ll. 23-27 and p. 5, ll. 24-26.

35 U.S.C. §102(e) Rejections

Claims 1, 3, 4, and 5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the German Reference. It is believed that the German Reference does not meet the requirements of 35 U.S.C. § 102(e), as it is not an application that has

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been filed in the United States nor does it satisfy the "international application" definition of § 102(e). As such, for at least this reason, the rejections under 35 U.S.C. § 102(e) are respectfully traversed.

Notwithstanding the above, claims 1, 3, 4, and 5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by the German Reference and claims 2 and 6-10 stand rejected under 35 U.S.C. § 103(a) as being either unpatentable over the German Reference in combination with Hong, or over the German Reference in combination with Hong in view of Cheney. Claim 1 relates, in part, to a direct-coated sponge abrasive material wherein an abrasive layer of the abrasive material comprises a coating on a surface of the sponge material together with binders which include abrasive material. For at least the reasons described below, the cited references fail to teach or suggest such limitations.

It is respectfully requested that the Examiner reconsider whether the German Reference teaches or suggests a direct-coated abrasive sponge material having an abrasive layer including a coating on the surface of the sponge material together with binders which include abrasive material. In particular, the Examiner has taken the position that "[c]laim 1 as amended does not exclude abrasive particles from being embedded within the sponge" and the German Reference "does not appear to show embedded particles within the sponge material as asserted by Applicant." *FOA 10-19-05* at p. 4. According to the clarifications presented below, it is believed that the Applicant's position merits reconsideration and allowance of the claims.

First, it is believed that the German Reference expressly teaches that abrasive particles are incorporated in the sponge material described therein. In contrast, independent claim 1 recites a direct-coated sponge abrasive material. As explicitly defined in the pending Specification, "direct-coated" sponge abrasive materials are defined as materials where abrasive material is coated on the surface of sponge materials and excludes abrasive products prepared by embedding abrasive particles into sponge substrates. *Specification* at p. 1, ll. 9-13. While Applicant respectfully

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disputes the Examiner's position that such a definition is contradictory with the parent case, the fact remains that the term has been expressly defined as such in the Specification. Regardless of the Examiner's position, the term as used in the claims should be given an interpretation consonant with definition of the term in the Specification. Furthermore, independent claim 1 describes an adhesive layer comprising a coating on the surface of the sponge material. In direct contrast, the German Reference teaches binders and abrasive in the sponge material.

For example, at page 4 of the translation of the German Reference, it is explicitly described that "the abrasive 2 is embedded in the foam." *Translation* at p. 4, last para. As another example, the German Reference translation describes abrasive grains (6) "within the foam bed." *Translation* at p. 5, 2nd para., ll. 13 and 14. Furthermore, the German Reference expressly states that the abrasive product described therein is especially well-suited to use with "non-sieveable" abrasives. *Translation* at p. 6, first full para. A reasonable reading of the German Reference is that very small abrasive particles are more readily receivable within foam cells of the abrasive article such that "the abrasive grains (6) . . . settle into the formed gaps [of the foam material]." *Id.* Still further, the German Reference expressly states that the foam or sponge-like material is "a part of the binder for the abrasive grains of the abrasive." *Translation* at p. 3, para. 7. In other words, the abrasive, foam material, and additional binders (if any) are mixed. In fact, the German Reference states that it's broad objective is achieved by the article of "proposed claim 1" (*Translation* at p. 3, second para.); proposed claim 1, in turn, clearly states that the abrasives are embedded into the foam or sponge. In view of the above, the German Reference fails to teach or suggest the limitations of claim 1, and more likely teaches away from such limitations.

For at least the reasons described above, it is believed that independent claim 1 presents patentably distinct material from the cited references. As claims 2-13 depend, in some form, from independent claim 1, they are believed similarly allowable. As such,

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it is respectfully requested that the rejections of claims 1-10 be withdrawn, with allowance of claims 1-13 and notice to that effect provided.

The dependent claims can be further distinguished from the cited references for additional reasons to those described above in association with independent claim 1. For example, new claim 11 relates to sponge material including a sheet of open-cell polyester-urethane foam, while new claim 12 relates to sponge material having a density of about 50 kilograms/meter³ to 100 kilograms/meter³. Following a good faith review, it is believed that none of the cited references teach or suggest such limitations. As such, new claims 11 and 12 are believed allowable over the cited references for at least such additional reasons.

As another example, new claim 13 relates to sponge material including a sheet of foam material free of abrasive particles. As described above, the German Reference expressly teaches incorporation of abrasive particles into foam material. As such, the German Reference fails to teach or suggest the limitations of new claim 13 and, more likely teaches away from such limitations. In view of the above, new claim 13 is believed allowable for at least such additional reasons.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-13 are in form for allowance and are not taught or suggested by the cited references. Therefore, consideration and withdrawal of the rejections and allowance of claims 1-13 are respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

Any inquiry regarding this Amendment and Response should be directed to either David B. Patchett at Telephone No. (651) 736-4713, Facsimile No. (651) 736-3833, or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-

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2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

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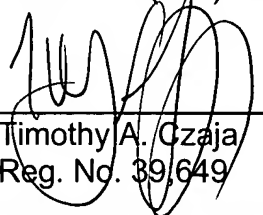
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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 19th day of January, 2006.

By: 

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